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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,873	12/31/2001	Meinolf Dingenotto	F-744 C	4655

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EXAMINER

PRASAD, CHANDRIKA

ART UNIT

PAPER NUMBER

2839

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,873

Applicant(s)

DINGENOTTO ET AL.

Examiner

Chandrika Prasad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/479,022.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

✓ 1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the followings must be shown or the feature(s) canceled from the claims 1-8. No new matter should be entered.

- ✓ • capacitor (claims 1-8),
- ✓ • base (claims 1-8) and
- ✓ • insular region (claims 1-8) and
- ✓ • monolithic planar filter (claims 1-8).

Specification

3. The following is a quotation of an appropriate paragraph of 37 CFR 1.75:

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(d) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See 1.58(a)).

- ✓ 4. Specification is objected under 37 C.F.R. 1.75(d) because a monolithic planar filter, capacitor, insular region and base have not been described in the specification.

Claim Objections

- ✓ 5. Claims 1-8 are objected to because of the following informalities: The independent claims 1 and 6 recite "having ground electrode to planarity", which is not clear. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following elements have been neither described in the specification nor shown in the drawings:

✓ Monolithic planar filter, capacitor, insular region and base.

- 5 ✓ 8. Claims 6-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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Claim 6, lines 8-13 implies a dielectric layer having two side surfaces ground to lap at least one side surface to planarity, which is not workable. How do you lap a side surface of an article by the article itself and what is meant by lap to planarity?

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

✓ 10. Claims 1-8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ 10. Claim 1 recites the limitation "the side surface having said ground electrode " in lines 11-12. There is insufficient antecedent basis for these limitations in the claim.

✓ 11. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: Claim 1 recites a supporting plate attached directly and closely to said planar filter but does not provide any specific to where or which part of the filter it is attached. The filter as claimed has a plurality of elements.

12. Claim 6 recites " ground to lap at least the side surface assigned having the ground electrode to planarity", which is not clear and indefinite.

Note: As best understood, the planar filter has a base of a dielectric material with signal electrodes on one side with a support plate attached directly to the signal electrodes. The base and the support plate has a plurality of through holes. A ground electrode is formed on the other side of the base in such a way that a clearance is provided around the through holes.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-2 and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Plass.

Plass (Figures 1 - 9) shows multi-pole angle socket connectors 1, 2; a plurality of conductor pins 6.1, 7.1 arranged in rows and columns; and a monolithic planar filter 10. The filter has openings for the conductors to pass through; a first layer with electrodes 16, a second layer of electrode 14; a base (dielectric layer) 15 made of titanate (such as barium titanate) in between the first and second layers, and a supporting plate 11 wherein all the layers and the supporting plate have through holes for the conductor pins to pass through, and the openings have soldered portions 16.1. The electrodes 16 are formed in a way to provide a clearance around the through holes.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Plass.

Plass shows all the features of this claim as described in Paragraph 14 above except the material of the base and the supporting plate. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to make the base of strontium titanate and the support plate having a dielectric constant lower than that of the base because it has been held to be within the general skill of a worker in the art to select a

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known material on the basis of its suitability for the intended use. In re Leshin, 125 USPQ 416.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lenker et al., Kawaguchi et al. and Cravens et al. also show filters having similar configurations.

Contact Information

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chandrika Prasad whose telephone number is (703) 308-0977.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild, can be reached at (703) 308-2710. The fax number for this Group is (703) 872-9318 (general) and (703) 872-9319 for after-final.

Any inquiry of a general nature or relating to the status of this application or processing should be directed to the Group receptionist whose telephone number is (703) 308-1782.



Chandrika Prasad

November 15, 2002